

Remarks/Arguments

The Rejection of Claims 1, 3, 4, 12, 14-20, 22-25 Under 35 U.S.C. §102

The Examiner rejected Claims 1, 3, 4, 12, 14-20, 22-25 under 35 U.S.C. §102(b) as being anticipated by applicant's admitted prior art. Applicant respectfully traverses the rejection.

Anticipation requires that all of the elements of the claim be taught within the four corners of a single reference.

Applicant has cancelled Claims 1, 16, and 17 and amended the remaining claims to depend from Claim 25.

Applicant has not admitted that it was known to coat the fasteners recited in the claims

The Examiner stated that Applicant admitted that in paragraphs [0031], [0033], and [0040], it was known to coat fasteners with adhesives. Applicant disagrees and has presented each of the preceding paragraphs for analysis:

“[0031] In a second embodiment, shown in FIGS. 3 and 4 and designated 110, outer surface 30 also comprises ridges 134. The ridges extend to the rear surface of flange 150. Adhesive 40 is located in patches on outer surface 30, covering a portion of ridges 134. Fastener 110 also comprises inner surface 120 and closed end 132. Fastener 110 has a circular cross section.” Applicant does not claim that ridges on a fastener are novel. In fact, in paragraph [0003], Applicant clearly states that the use of hexagonal blind rivet nuts is known. However, Applicant clearly states that in the second embodiment of the invention adhesive is applied to a surface comprising a ridge. In this paragraph, Applicant is fulfilling the requirements of 35 USC 112 by providing an adequate written description, enablement, and best mode of what is claimed. Applicant has made no statement that a ridged fastener with an adhesive on the flange (as recited in Claim 25) is known in the prior art.

“[0033] Fastener 210 does not have a closed end. Instead, threaded portion 222 of inner surface 220 is visible in FIG. 5 through the open end of fastener 210. Fasteners with open ends or with closed ends are within the spirit and scope of the invention as claimed. Fastener 210 also comprises flange 250. Fastener 210 has a circular cross section.” The preceding paragraph is

with respect to Figures 5 and 6, which show a third embodiment of the invention. Applicant does not claim that all the aspects of a fastener, such as a knurled surface, described for Figures 5 and 6 (for example, in paragraph [0033]) are novel. However, Applicant clearly states that in this embodiment of the invention, adhesive is applied to a surface of a fastener. Again, Applicant is fulfilling the requirements of 35 USC 112 by providing an adequate written description, enablement, and best mode of what is claimed. Applicant has made no statement that a fastener, as shown in Figures 5 and 6, coated with an adhesive is known in the prior art.

"[0040] FIG. 17 shows the present invention securing together members 62 and 64, and screw 70 engaged with the threaded inner surface 22." This paragraph described present invention fasteners in use. Applicant has made no statement that a fastener coated with an adhesive is known in the prior art.

Nowhere in the specification has Applicant made a statement that a fastener coated with an adhesive is known in the prior art. For example, paragraphs [0029], [0034], [0036], [0037], and [0038] describe first, fourth, fifth, sixth, and seventh embodiments of the invention. Each embodiment describes a characteristic of a fastener, for example, a specific shape, which is not claimed to be novel, and then describes the claimed novelty, namely, coating an outer surface or flange of the fastener with adhesive. These paragraphs fulfill the requirements of 35 USC 112.

Applicant has amended the remaining dependent claims to depend from Claim 25, which recites: "a flange and at least a portion of a surface of said flange has an adhesive thereon." Applicant makes no statement that a fastener with an adhesive on the flange (as recited in Claim 25) is known in the prior art.

Dalton does not teach applying adhesive to a fastener recited in Claim 25

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Examiner has not cited a single prior art reference that meets the requirements of *Verdegaal* or *Richardson*.

Claim 25 recites: “a fastener selected from the group including a rivet nut, a rivet nut stud, a threaded insert, and a blind threaded insert, wherein said fastener has *an inner surface* (emphasis added) and an outer surface ...” Applicant has shown *supra* that Applicant’s own specification, does not contain any admission that a fastener, such as recited in Claim 25, with an adhesive on the flange is known in the prior art.

The Examiner stated that Applicant incorporated Dalton by reference and Dalton teaches adhesive coating of rivets, threaded nuts, bolts, and flanged fasteners and the use of encapsulated adhesives. Dalton teaches a solid rivet, which is different than the fasteners recited in Claim 25. For example, the fasteners recited in Claim 25 have inner and outer surfaces. A solid rivet, as shown in Figures 1 and 3 of Dalton, does not have an inner surface.

The fasteners recited in Claim 25 are in general, blind rivet nuts. Therefore, in addition to the extensive structural differences between the fasteners recited in Claim 25 and Dalton’s solid rivets, the fasteners recited in Claim 25 work on a completely different principle than Dalton’s solid rivets, and are used in completely different applications than Dalton’s solid rivets. For example, Figure 16 in the present specification shows a “blind” application. In contrast, Figure 4 in Dalton shows that the solid rivet has been accessed on both ends and peened at both ends.

Dalton does not inherently disclose the fasteners recited in Claim 25. “Moreover, a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference.” *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 [20 USPQ2d 1746] (Fed. Cir. 1991). Having an inner surface is not necessarily present in Dalton’s solid rivet. In fact, an inner surface is necessarily not present in a solid rivet.

For all the reasons noted above, Applicant has not admitted any prior art that anticipates Claim 25. Therefore, Claim 25 is novel. Amended Claims 3, 4, 12, 14, 15, 18-20, and 22-24,

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dependent from Claim 25, enjoy the same distinction from the cited reference. Applicant courteously requests that the rejections be removed.

The Rejection of Claims 1, 3, 4, 6-8, 12, 14-17, 20, and 23-25 Under 35 U.S.C. §102

The Examiner rejected Claims 1, 3, 4, 6-8, 12, 14-17, 20, and 23-25 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,082,405 (Witten). Applicant respectfully traverses the rejection.

Anticipation requires that all of the elements of the claim be taught within the four corners of a single reference.

Applicant has cancelled Claims 1, 7, 8, 16, and 17 and amended the remaining claims to depend from Claim 25.

Witten does not teach a fastener as recited in Claim 25

Witten teaches a potted insert, which is designed to engage, along its entire length, a solid matrix, for example, the honeycomb panel shown in Figures 8 and 9. Claim 25 recites: “a rivet nut, a rivet nut stud, a threaded insert, and a blind threaded insert,” all of which are blind rivet nuts. Blind rivet nuts are not the same as the potted insert taught by Witten. Blind rivet nuts are generally used to fasten relatively thin sheets of material together. Also, a fundamental aspect of blind rivet nuts is that the body of the rivet nut is expandable to hold the sheets or other material between the flange of the rivet nut and the expanded body, as shown in Figures 16 and 17 of the present application. Witten teaches a completely different physical structure, principle of operation, and application for the potted insert.

Witten does not inherently disclose the fasteners recited in Claim 25. “Moreover, a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference.” *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 [20 USPQ2d 1746] (Fed. Cir. 1991). Having the structure of a blind rivet nut is not necessarily present in Witten’s potted insert. In fact, such a structure is necessarily not present in Witten’s potted insert, since an expanding body would damage the honeycomb panel.

Witten does not teach any fastener with an adhesive coating

Claim 25 recites: “a flange and *at least a portion of a surface of said flange has an adhesive thereon* (emphasis added);” Witten does not disclose this element. Instead, Witten teaches an insert, not coated with an adhesive, and inserted into a hole into which adhesive has already been placed in a separate operation: “To mount the element 10 in the panel, the *opening 48 first receives a quantity of epoxy adhesive* (emphasis added) 50. The element 10 is then inserted through the opening 44A formed in the outer skin 40 so that the epoxy 50 completely fills the opening 48 between the inner skin 44 and the outer skin 46, and surrounds and contacts all external surfaces of the element 10.” (col. 3, lines 45-51).

Assuming *arguendo* that Witten’s above procedure was equivalent to a fastener with an adhesive thereon, which it is not, Witten’s procedure would only coat the body of the potted insert, not any flange that might be included on the potted insert. The adhesive is applied to the hole and then the potted insert is inserted in the hole. That is, only the body of the potted insert would be in contact with the adhesive in the hole.

Witten does not teach each and every element as set forth in Claim 25. Therefore, Claim 25 is novel with respect to Witten. Claims 3, 4, 6, 12, 14, 15, 20, 23, and 24, dependent from Claim 25, enjoy the same distinction from the cited reference. Applicant courteously requests that the rejections be removed.

The Rejection of Claims 1, 12, 13, and 22 Under 35 U.S.C. §103

The Examiner rejected Claims 1, 12, 13, and 22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,082,405 (Witten) in view of U.S. Patent No. 4,632,944 (Thompson). Applicant respectfully traverses the rejection. Applicant has cancelled Claim 1 and has amended Claims 12, 13, and 22 to depend from Claim 25.

Claim 25 is patentable over Witten and Thompson

Applicant notes that the Examiner has not rejected Claim 25 over Witten in view of Thompson. Applicant presumes that the Examiner has determined that Claim 25, which is not amended in this response, is patentable over Witten and Thompson due at least to the limitation

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of a flange recited in Claim 25. Applicant notes this allowance of Claim 25 with appreciation. Amended Claims 12, 13, and 22, dependent from Claim 25, also are patentable over Witten and Thompson.

The Rejection of Claims 1, 12, and 13 Under 35 U.S.C. §103

The Examiner rejected Claims 1, 12, and 13 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,082,405 (Witten) in view of Loctite Product 204 Product Description Sheet (Loctite) as cited by Applicant. Applicant respectfully traverses the rejection. Applicant has cancelled Claim 1 and has amended Claims 12 and 13 to depend from Claim 25.

Claim 25 is patentable over Witten and Loctite

Applicant notes that the Examiner has not rejected Claim 25 over Witten in view of Loctite. Applicant presumes that the Examiner has determined that Claim 25, which is not amended in this response, is patentable over Witten and Loctite at least due to the limitation of a flange recited in Claim 25. Applicant notes this allowance of Claim 25 with appreciation. Amended Claims 12 and 13, dependent from Claim 25, also are patentable over Witten and Loctite.

The Rejection of Claims 18 and 19 Under 35 U.S.C. §103

The Examiner rejected Claims 18 and 19 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,082,405 (Witten) in view of U.S. Patent No. 5,733,083 (Heminger). Applicant respectfully traverses the rejection. Applicant has cancelled Claim 1 and has amended Claims 18 and 19 to depend from Claim 25.

Claim 25 is patentable over Witten and Heminger

Applicant notes that the Examiner has not rejected Claim 25 over Witten in view of Heminger. Applicant presumes that the Examiner has determined that Claim 25, which is not amended in this response, is patentable over Witten and Heminger at least due to the limitation of a flange recited in Claim 25. Applicant notes this allowance of Claim 25 with appreciation.

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Amended Claims 18 and 19, now dependent from Claim 25, also are patentable over Witten and Heminger.

The Rejection of Claims 1, 2-4, 6, 12, 14, 16, 20, 22, and 24 Under 35 U.S.C. §103

The Examiner rejected Claims 1, 2-4, 6, 12, 14, 16, 20, 22, and 24 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,853,841 (Castor). Applicant respectfully traverses the rejection. Applicant has cancelled Claims 1 and 16 and has amended Claims 2-4, 6, 12, 14, 20, 22, and 24 to depend from Claim 25.

Claim 25 is patentable over Castor

Applicant notes that the Examiner has not rejected Claim 25 over Castor. Applicant presumes that the Examiner has determined that Claim 25, which is not amended in this response, is patentable over Castor at least due to the limitation of a flange recited in Claim 25. Applicant notes this allowance of Claim 25 with appreciation. Amended Claims 2-4, 6, 12, 14, 20, 22, and 24, dependent from Claim 25, also are patentable over Castor.

Conclusion

Applicant respectfully submits that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,

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